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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,686	01/27/2004	Edward A. Jakush	CFT-007COA	2099
28661 7590 03/23/2007 SIERRA PATENT GROUP, LTD. 1657 Hwy 395, Suite 202 Minden, NV 89423			EXAMINER TOOMER, CEPHIA D	
			ART UNIT	PAPER NUMBER
			1714	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/766,686

Applicant(s)

JAKUSH ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18-22, 30-43, 47-51 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18-22, 30-43, 47-51 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the amendment filed January 8, 2007.

The rejection of the claims under 35 U.S.C. 112, second paragraph is withdrawn in view of the amendment to the claims.

Specification

1. The amendment filed January 8, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the added subject in paragraph 0042.

Applicant is required to cancel the new matter in the reply to this Office Action.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-14, 18-22, 30-43, 47-51 and 56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,656,236. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elimination of a step of blending or the sequence of adding the ingredients is prima facie obvious in the absence of unexpected results.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-26, 28-55 and 57-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubin (US 5,284,492) in view of Peter-Hoblyn (US 5,743,922).

Dubin teaches an enhanced lubricity water and fuel oil emulsion (see column 3, lines 31-37). The emulsion can be either a water in fuel oil or a fuel oil in water emulsion (see column 3, lines 41-44). The oil phase comprises a light fuel oil, by which is meant a fuel oil having little or no aromatic compounds and consists essentially of relatively low molecular weight aliphatic and naphthenic hydrocarbons (see column 3,

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lines 45-49). Such fuels include diesel fuel (column 3, lines 61-68). The emulsions advantageously comprise water-in-fuel oil emulsions having up to about 90% water by weight. The emulsions which have the most practical significance in applications when combusted alone are those having about 5% to about 50% water and are preferably about 10% to about 35% water-in-fuel oil by weight (see column 4, lines 7-15).

Although demineralized water is not required, the use of demineralized water in the emulsion is preferred (see column 4, lines 30-35). The skilled artisan recognizing that the pH of demineralized water is about 7.

The emulsions are prepared such that the discontinuous phase preferably has a particle size wherein at least about 70% of the droplets are below about 5 microns Sauter mean diameter. More preferably, at least about 85%, and most preferably at least about 90% of the droplets are below about 5 microns Sauter mean diameter (see column 4, lines 38-44). An emulsification system is most preferably employed to maintain the emulsion. A desirable emulsification system comprises about 35% to about 85% by weight of an amide, especially an alkanolamide or n-substituted alkyl amine; about 5% to about 25% by weight of a phenolic surfactant; and about 0% to about 40% by weight of a difunctional block polymer terminating in a primary hydroxyl group. These compounds encompass Schercomid SO-A and Pluronic brand compounds (see column 5, lines 2-59). The addition of a component selected from the group consisting of dimer and/or trimer acids, sulfurized castor oil, phosphate esters, and mixtures thereof significantly increase the lubricity of the emulsion (see column 7,

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line 15- column 8, lines 1-28). The addition of a corrosion inhibitor is taught in column 8, lines 56 to column 9, line 2.

Dubin teaches that the apparatus used to prepare the emulsion is an in-line emulsifying device and that the emulsion is formed by feeding both the water and the fuel oil in the desired proportions to the emulsifying apparatus. The emulsification system (additives) can either be admixed or dispersed into one or both of the components before emulsification. Dubin teaches the limitations of the claims other than the differences that are discussed below.

With respect to the composition claims, Dubin differs from the instant claims in not disclosing the claimed method of forming the emulsion. However, the patentability of a product does not depend on its method of production, *In re Thorpe*, 227 USPQ at 966.

With respect to the method claims, Dubin sets forth that the emulsion may be prepared using an in-line emulsifying apparatus. This teaching suggests that the skilled artisan recognizes that the additives and fuel may be blended in one line and adding this mixture to the water that comes from another line. The additive, fuel, and water are blended and allowed to settle (aging process) and then the mixture is emulsified. There is nothing unobvious about the claimed method steps. Furthermore, Peter-Hoblyn teaches that the claimed method step of aging the mixture before emulsification is conventional (see Fig 1).

6. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the examiner has failed to provide a teaching of each and every limitation of claim 1 and has not provided a proper motivation to combine the references, specifically Applicant argues that neither Dubin nor Peter teaches the aging of a composition in the process of making an emulsion.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dubin and Peter teach emulsified fuels containing similar components wherein the fuels are blended by use of an inline-emulsifying device. While Dubin does not teach the step of aging the emulsion, Peter teaches that after exiting the emulsifier the diesel fuel emulsion is directed to an emulsion tank before it is fed to the fuel tank. This teaching suggests the claimed aging step.

Applicant argues that Peter teaches away from aging because it may allow components to settle.

The examiner respectfully disagrees. Peter teaches that after being emulsified the emulsion can be stored in an appropriate storage tank prior to combustion (see col. 3, lines 18-22). Furthermore, Peter teaches that the emulsification system maintains the emulsion stability (see col. 6, lines 54-57).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cephia D. Toomer
Primary Examiner
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